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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,933	06/20/2001	Olivier Attia		3723

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WILMERHALE/NEW YORK  
399 PARK AVENUE  
NEW YORK, NY 10022

EXAMINER
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DESHPANDE, KALYAN K

ART UNIT	PAPER NUMBER
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3625

NOTIFICATION DATE	DELIVERY MODE
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08/01/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 09/883,933	<b>Applicant(s)</b> ATTIA, OLIVIER	
	<b>Examiner</b> Kalyan K. Deshpande	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 20-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/10/08</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Introduction***

The following is a final office action in response to the communications received on March 11, 2008. Claims 20-34 are now pending in this application.

### ***Response to Amendments***

Applicants' cancellation of claims 4, 6-7, 9, 17, and 19. New claims 20-34 are acknowledged.

### ***Response to Arguments***

Applicants' arguments filed on March 11, 2008 have been fully considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 20-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 20-34 recite the limitation "if at least one product substitute is found in the product database, adding the at least one product substitute to the substitute table and sending the customer a recommendation of the at least one product substitute". It is unclear from this limitation how a substitute product could be a substitute product without being in the substitute table. For the purposes of examination, Examiner is

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interpreting this limitation to mean if a product substitute exists, sending the customer a recommendation of the product substitute.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (U.S. Patent No. 6970837) in view of Green et al. (U.S. Patent No. 5664110).

Referring to claim 20, Walker teaches "a method for managing scan-based input, comprising: receiving a plurality of barcodes at a server from a customer" (see Walker column 7 lines 56-67 and column 8 lines 1-30; where bar codes are received to identify products.), "resolving each of the plurality of barcodes into a corresponding plurality of product identifiers, said plurality of product identifiers stored in a product database in communication with said server" (see Walker column 7 lines 56-67 and column 8 lines 1-30; where bar codes are received to identify products.), "receiving a selection of a first product in response to a barcode of said plurality of barcodes being scanned by the customer" (see Walker column 7 lines 28-44; where a bar code identifies a product selected by a customer.), "determining whether said first product is available by querying said product database" (see Walker column 13 lines 8-20 and column 20 lines

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12-19; where a determination is made whether a first product is in stock, i.e. available.), "if it is determined that said first product is not available by querying said product database, determining whether a substitute product is indicated in a substitute table" (see Walker column 13 lines 8-20 and column 20 lines 12-19; where a substitute product is offered if the first product is not available. The substitute product is identified by a substitute product identifier value.), "if at least one product substitute is found in the product database, adding the at least one product substitute to the substitute table and sending the customer a recommendation of the at least one product substitute" (see Walker column 13 lines 8-32 and column 17 lines 17-29; where a substitute product is recommended to the buyer.), "receiving approval from the customer in response to the recommendation of a product substitute" (see Walker column 11 lines 55-67, column 12 lines 56-65, column 24 lines 34-50, column 25 lines 14-36, and figure 11B; where approval from the customer in response to a substitute product offer is received.), and "in response to the approval, saving the approved substitute product in a shopping cart of the customer" (see Walker column 11 lines 55-67, column 12 lines 56-65, column 24 lines 34-50, and column 25 lines 14-36; where payment for the substitute product is collected. This is functionally the same as adding the substitute product to the shopping cart.).

Walker fails to teach "creating a catalog including the plurality of barcodes and a corresponding plurality of product descriptions arranged such that each barcode of the plurality of barcodes is located in proximity of a product description of the plurality of product descriptions which it identifies" and "sending the catalog to the customer".

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Green, in an analogous art, explicitly teaches "creating a catalog including the plurality of barcodes and a corresponding plurality of product descriptions arranged such that each barcode of the plurality of barcodes is located in proximity of a product description of the plurality of product descriptions which it identifies" (see Green column 3 lines 5-21; where a catalog of bar codes is described.) and "sending the catalog to the customer" (see column 3 lines 5-21 and figures 2-4). The advantage of such features is that they further the organization of products for sale facilitating a user's ability to find products to purchase thereby enhancing sales. It would have been obvious, at the time of the invention, to one of ordinary skill in the art to combine these features taught by Green to Walker in order to ultimately further sales.

Referring to claim 21, Walker fails to explicitly teach "sending the customer catalog to the customer comprises sending the customer a markup language file including the catalog". Examiner takes Official Notice that it is old and well-known in the art to send a markup file with an attachment, such as a catalog, to a customer. A markup file includes commonly used markup files such as html files. The advantage of such a feature is that it facilitates delivery of marketing information to customers. It would have been obvious, at the time of the invention, to one of ordinary skill in the art to modify Walker to includes this feature in order to facilitate the delivery of marketing information to customers.

Referring to claim 22, Walker teaches "calculating a degree of closeness between the at least one product substitute and the first product" (see Walker figures 11-13) and "storing the degree of closeness in the substitute table" (see Walker figures 11-13).

Referring to claim 23, "a product is not available if it is out of stock" (see Walker column 13 lines 8-20 and column 20 lines 12-19; where a determination is made whether a first product is in stock, i.e. available.).

Referring to claim 24, walker teaches "determining whether a particular barcode of the plurality of barcodes is stored in said product database" (see Walker column 7 lines 56-67 and column 8 lines 1-30), "if the particular barcode is not stored in said product database, querying at least one code registry to locate a particular product substitute" (see Walker figures 11-13), "sending the customer a recommendation of the particular product substitute" (see Walker column 13 lines 8-32 and column 17 lines 17-29), "receiving approval from the customer in response to the recommendation of the particular product substitute" (see Walker figure 11B), and "in response to the approval from the customer in response to the recommendation of the particular product substitute, resolving the particular barcode into a product identifier of the particular product substitute" (see Walker figures 11-13)."

Claims 25-29 recite "a computer-readable medium storing computer-executable instructions that, when executed by a processor, cause the processor to perform a method for facilitating purchases" taught by Walker (see Walker figures 1 and 4). Claims 25-29 further recite limitations already addressed by the rejections of claims 20-24; therefore the same rejections apply to these claims.

Claims 30-34 recite "a system for managing scan-based input, comprising: a product database, a memory storing a substitute table, a network interface, a processor in communication with the product database, the memory, and the network interface" taught by Walker (see Walker figures 1, 4, and 11-13). Claims 30-34 further recite limitations already addressed by the rejections of claims 20-24; therefore the same rejections apply to these claims.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any



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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kalyan K. Deshpande whose telephone number is (571)272-5880. The examiner can normally be reached on M-F 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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